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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/063,315

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Alejandro Berenstein

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EXAMINER

SEVERSON, RYAN J

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

07/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/063,315	Applicant(s) BERENSTEIN ET AL.	
	Examiner Ryan J. Severson	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-41 and 43-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-41 and 43-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 38-41, 44, 46-49 and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imran (5,817,126) in view of Vonesh et al. (6,336,937) and Hojeibane (5,911,732).** Imran discloses a stent (see figure 1) having a coil segment (60) and serpentine segments (20 and 40). The coil portion has a greater length than either of the serpentine segments (see figure 1). However, Imran does not disclose one segment being self-expanding and the other segment being balloon expanding. Attention is drawn to Vonesh et al., who teach a stent may have some sections balloon expanding (56) and the adjacent segments self expanding (59, see figures 7 and 8) to create a stent where consistent performance along the length is not desired (see also column 11, lines 47-59 and particularly lines 54-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create the segmented stent of Imran with both balloon and self-expanding portions, as taught by Vonesh et al., to create a stent where consistent performance and expansion characteristics is not desired.

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3. Further, the combination of Imran and Vonesh et al. does not disclose the middle segment is a coil segment. Attention is drawn to Hojeibane, who teaches the use of a coil segment (5, see figure 3) to connect non-coil segments (271 and 272) to increase the flexibility of the stent (particularly the region between the non-coil segments).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the segment (60) of the combination of Imran and Vonesh et al. a coil segment in the manner taught by Hojeibane to increase the flexibility of the stent.

4. Regarding claims 39 and 49, the end segments of the stent (20 and 40) are the serpentine segments.

5. Regarding claim 40, there is only one coil segment (60, which is replaced by a coil in the manner taught by Hojeibane described above) in the stent and that segment connects the two serpentine end segments.

6. Regarding claims 41 and 48, as taught by Vonesh et al., the first and second ends can be self expanding (as in figure 8 of Vonesh et al.).

7. Regarding claims 44 and 47, as taught by Vonesh et al., the first and second ends can be balloon expanding (as in figure 7 of Vonesh et al.).

8. Regarding claims 51-53, the combination of Imran, Vonesh et al, and Hojeibane does not disclose the specific sizes of the deployed segments. However, it has been held where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

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9. **Claims 43, 45 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imran (5,817,126) in view of Vonesh et al. (6,336,937) and Hojeibane (5,911,732) as applied to claims 38 and 46 above, and further in view of Klein (5,593,442).** The combination of Imran, Vonesh et al, and Hojeibane does not disclose the segments be made of spring steel. Attention is drawn to Klein, who teaches it is well-known in the art to use spring steel in stents (see column 4, lines 53-60) to provide a stent with resiliency. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the stent segments of the combination of Imran, Vonesh et al, and Hojeibane of spring steel, as taught by Klein, to provide a stent that is resilient.

Response to Arguments

10. Applicant's arguments filed 4/2/2009 have been fully considered but they are not persuasive.

11. Applicant argues one of ordinary skill in the art would not modify Imran with Hojeibane because the spiral would "be expected" to lack luminal support when incorporated into the stent of Imran. However, Examiner can find no evidence to support this assertion, and notes that the phrase "would be expect" makes clear applicant can provide no evidence to support this assertion, and that this assertion is merely conjecture and opinion on the part of the applicant. Merely substituting the braided structure with the helical coil structure would not impact the stents ability to support a lumen.

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12. Further, replacing the braided section with the coil section would increase the flexibility of the stent, which is a desirable characteristic in stents when the stent is not implanted in a perfectly straight lumen. It is the Examiners position that changing the length of the coil section is obvious and within the level of one of ordinary skill in the art.

13. Examiner notes that the limitation “adjacent *portions* aligned in a circumferential direction” fails to differentiate over Hojeibane in particular because each coil can be arbitrarily divided into “portions” to meet this limitation. The limitation does not define what is considered a singular portion and what structure is included in the portion.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J. Severson whose telephone number is (571) 272-3142. The examiner can normally be reached on Monday - Friday 8:30-5:00.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. J. S./
Examiner, Art Unit 3731
7/29/09

/Anhtuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731